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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,791	05/30/2000	Yuhpyng L. Chen	U-014293-3	8367

7590

09/05/2003

Ladas & Parry  
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New York, NY 10023

EXAMINER

JONES, DWAYNE C

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 09/05/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant(s)

09/580,791

CHEN, YUHPYNG L.

Examiner

Dwayne C Jones

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 29-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 30-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 15 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11,14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-15 and 29-45 are pending.
2. Claims 1-14, and 30-45 are rejected..
3. Claim 15 is non-elected and withdrawn from consideration.

### ***Election/Restrictions***

4. Claim 15 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7, of April 10, 2003. In addition, claims 16-28 were cancelled in Paper No. 9, which was the amendment of December 23, 2002. It appears that claim 15 was inadvertently not included in this cancellation of non-elected claims. Please address the status of this claim.

### ***Information Disclosure Statement***

5. The information disclosure statements filed on April 14, 2003 and July 17, 2003 have been reviewed and considered, see enclosed copies of PTO FORMs 1449.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1614

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 13, 14, and 30-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claim 13 is directed to a pharmaceutical composition for the treatment of a "disorder or condition of which can be effected or facilitated by antagonizing CRF" as well as laundry list of disorders or conditions and claim 14 is also direct a laundry list of disorders or conditions that are not adequately described in the instant specification. There is insufficient descriptive support for the functional term of a "disorder or condition of which can be effected or facilitated by antagonizing CRF" as well as laundry list of disorders or conditions. Moreover, the specification does not adequately describe what is meant by the functional characteristics of the of a "disorder or condition of which can be effected or facilitated by antagonizing CRF" as well as laundry list of disorders or conditions. The specification only has described the binding activities for compounds I, II and III as they are possessing CRF antagonist activity. There is no description of an actual reduction to practice, each step of the claimed pharmaceutical method with its intended use in order to show that the applicant was in possession of the claimed invention. Therefore, the claim fails to comply with the written description requirement.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1614

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1 and 13, 14 and 29-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 defines the variable of  $R_1$  as the group, "S(C<sub>3</sub>-C<sub>5</sub> cyclohydrocarbyl - - N(C<sub>1</sub>-C<sub>4</sub> hydrocarbyl)CO(C<sub>1</sub>-C<sub>4</sub> hydrocarbyl)". It is unclear why there are two dashes present. More specifically, should this indicate only one dash or should one dash be a comma in order to list the next group that  $R_1$  can represent? Under the variable section for  $R_1$ , the group, "S<sup>+</sup>(C<sub>1</sub>-C<sub>6</sub> hydrocarbyl)(C<sub>1</sub>-C<sub>2</sub> hydrocarbyl)" seems to be electronically unbalanced because its counter anion is missing, such as iodide, I<sup>-</sup>. For these reasons, these claims are rendered vague and indefinite.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-12 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cossey et al. Cossey et al. teach of cyanoacetamide pyridine compounds of formulas (I) and (7), (see pages 1039 and pages 1040). Cossey et al. also teach that the variables of R and R' can be represented by H, and short chain alkyl groups, (see pages 1041-1046).

Art Unit: 1614

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 1-14, and 30-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosoi et al. of U.S. Patent No. 4,839,353. Hosoi et al. teach of pyridine derivative compounds as represented by general formula (I), (see columns 1-4). The instant claims differ from the Hosoi et al. reference by reciting a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those of the claims, because an ordinary artisan would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as the genus as a whole.

***Obviousness-type Double Patenting***

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 1-14 and 30-45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 and 17-22 of copending Application No. 09/761,995. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are directed to pyridine-containing compounds.

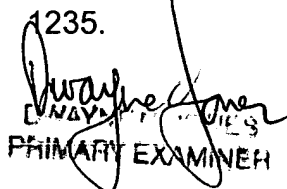
17. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (703) 308-4634. The examiner can normally be reached on Mondays through Fridays from 8:30 am to 6:00 pm. The examiner can also be reached on alternate Mondays.

Art Unit: 1614

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
WAYNE JONES  
PRIMARY EXAMINER

Tech. Ctr. 1614  
August 31, 2003